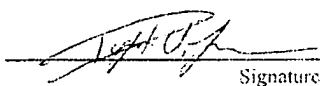


PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number: 13906-171001
I hereby certify under 37 CFR § 1.5(a) that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to Mail Stop AF, Commissioner for Patents, Box 1450, Alexandria, VA 22313-1450.	Application Number 10/824,106	Filed April 14, 2004
	First Named Inventor Janaki P. Kumar	
	Art Unit 2129	Examiner Peter D. Coughlan
	Date of Deposit Signature Typed or Printed Name of Person Signing Certificate	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a Notice of Appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record <u>53,688</u> (Reg. No.)</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34</p>		
		 Signature Dwight U. Thompson Typed or printed name (202) 783-5070 Telephone number February 13, 2008 Date
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.		
<input checked="" type="checkbox"/> Total of 1 form is submitted.		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Janaki P. Kumar
Serial No. : 10/824,106
Filed : April 14, 2004
Title : RULE TEMPLATES

Art Unit : 2129
Examiner : Peter D. Coughlan
Conf. No. : 6151

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Pursuant to United States Patent and Trademark Office OG Notices: 12 July 2005 - New Pre-Appeal Brief Conference Pilot Program, a request for a review of identified matters on appeal is hereby submitted with the Notice of Appeal. Review of these identified matters by a panel of examiners is requested because the rejections of record are clearly not proper and are without basis, in view of a clear legal or factual deficiency in the rejections. All rights to expand the identified matters and/or address additional matters on appeal in any subsequent appeal brief are hereby reserved.

Status of Claims

Claims 1-9, 13-16, 18, and 20 are pending, with claims 1, 18, and 20 being independent. In an Office Action mailed on November 13, 2007, claims 1, 3-6, 8, 18, and 20 were rejected under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement. Claims 1-9, 13-16, 18, and 20 are rejected under 35 U.S.C. §102(b) (hereinafter referred to as Thurlow) as allegedly being anticipated by Thurlow et al., U.S. 6,057,841.

The September 28, 2007 Response to the May 29, 2007 Office Action is incorporated by reference herein in its entirety.

Response to Arguments in Office Action: Item #6, pages 20-22

On pages 21-22, the Examiner states that claims 1, 3, 5, 8, 18, and 20 are unclear because there is not an explicit definition for "attribute name" in the specification, and because the "Examiner is allowed the broadest interpretation of a claim," there are "undisclosed definitions thus resulting in undisclosed purposes or functions." Applicant specifically asks the panel to review the issue of whether the patent specification describes the claimed subject matter in sufficient detail that one skilled in the art can reasonably conclude that the inventor had

possession of the claimed invention. Applicant submits that the specification does so, as described more fully below.

Applicant submits that the rejection to claims 1, 3, 5, 8, 18, and 20 under 35 U.S.C. 112, first paragraph, is improper for at least the following reasons.

1. As a matter of law, requiring an *explicit definition* of a claim limitation under 35 U.S.C. 112, first paragraph, is a legal error. To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. (MPEP 2163) *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563 (Fed. Cir. 1991). Applicant again respectfully submits that the disclosure in the specification does so, as discussed on page 9, paragraphs 4-5 of the September 28, 2007 Response. Hence, requiring an *explicit definition* of an "attribute name" is a legal error.
2. The claim term itself would have been apparent to one skilled in the art at the time the application was filed and need not be explicitly defined. For example, as indicated in the MPEP:
 - ☐ "[i]nformation that is well known in the art need not be described in detail in the specification." (MPEP 2163) *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379-80, (Fed. Cir. 1986).
 - ☐ "[w]hat is conventional or well known to one of ordinary skill in the art need not be disclosed in detail." (MPEP 2163) *Hybritech*, 802 F.2d at 1384.
3. The Examiner is allowed to use have a "reasonable" basis for the rejection, and is not allowed to have the "broadest interpretation of a claim" as stated on page 22 in the Office Action. Also, that broadest *reasonable* interpretation should be consistent with the specification. *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 957, 220 USPQ 592, 597 (Fed. Cir. 1983), cert. denied, 469 U.S. 835 (1984). Applicant submits that the rejection cannot be supported for reasons stated on page 9, paragraphs 4-5 of the September 28, 2007 Response, and the numerous examples providing support for the claimed term within the specification.
4. As stated by the court in *In re Marzocchi*, "it is incumbent upon the Patent Office, whenever a rejection on this basis is made, to explain why it doubts the truth or accuracy of any statement in a supporting disclosure and to back up assertions of its own with acceptable evidence or reasoning which is inconsistent with the contested statement. Otherwise, there would be no need for the applicant to go to the trouble and expense of supporting his presumptively accurate disclosure." 439 F.2d at 224, 169 USPQ at 370 (CCPA 1971). The Office Action did not provide an explanation of why the Examiner doubts the truth or accuracy of the disclosure that would not enable one skilled in the art to make and use the invention as contemplated by the inventor.
5. Moreover, the action has not met the burden placed on the Examiner "of presenting evidence or reasoning to explain *why persons skilled in the art would not recognize in the original*

disclosure a description of the invention defined by the claims.” (MPEP 2163) *In re Wertheim*, 646 F.2d 527 (CCPA 1976) (emphasis added). Hence, the action does not provide evidence of why *one skilled in the art* would not have recognized what an “attribute name” was after one skilled in the art read the specification and its figures. (Also, consider the related *Wands* factors, including the nature of the invention, the level of one of ordinary skill, the amount of direction provided by the inventor, and the existence of working examples. (MPEP 2164))

For at least these reasons, the rejection to claims 1, 3, 5, 8, 18, and 20 under 35 U.S.C. 112, first paragraph, is improper and should be withdrawn.

Response to Office Action Arguments: Item #7, pages 22-23

On pages 22-23, the Examiner states that claims 1, 3-6, 18, and 20 are unclear because there is not an explicit definition for “operator” in the specification, and because “this limitation is so broad the specification only touches what it could mean.” Applicant submits that the rejection under 35 U.S.C. 112, first paragraph to claims 1, 3-6, 18, and 20 is improper for at least the five reasons stated above as pointed out in the September 28, 2007 Response for the “operator” limitation.

Further, by stating that the “operator” can be a spell checker or a spread sheet application, the Examiner is not considering the scope of the claim with the disclosure itself such that one skilled in the art could reasonably conclude that the inventor had possession of the claimed invention.

For at least these reasons, Applicant asks that the rejection to claims 1, 3-6, 18, and 20 under 35 U.S.C. 112, first paragraph, be withdrawn and these claims be allowed.

Response to Arguments in Office Action: Item #8, pages 23-25

Page 25, paragraph 1 of Office Action alleges that the Applicant’s statement of “the condition of the user defined rule” is equivalent to “creating and editing rules where at each step the user selects the parameters that constitute the rule” of Thurlow. The Applicant disagrees. Thurlow fails to disclose a method that includes “**creating**, in response to the received user input, **a rule template** having a condition that is based upon the condition of the user-defined rule,” as recited in claim 1 (emphasis added). As stated on pages 12-13 of the September 28, 2007 Response, **Thurlow discloses using a pre-existing rule template to create a rule, but**

does not disclose using a condition of a pre-existing rule to create a rule template (Thurlow: 2:38-46). In Thurlow, the rule templates are already existing before a user can even view a displayed list of rule templates, (Thurlow: 2:38-46); and hence, the pre-existing rule templates themselves are not created by a pre-existing rule. Because at least Thurlow discloses that the rule templates are used to create the rule rather than using the rule itself to create the rule template, Thurlow fails to disclose each and every feature of claims 1-9, 13-16, 18, and 20. Applicant asks that the rejection to these claims under 35 U.S.C. 102(b) be withdrawn and these claims be allowed.

Response to Arguments in Office Action: Item #9, pages 25-26

On page 26, paragraph 2 of the Office Action states that “since editing can be accomplished with Thurlow in regards to a template, there is only need for a single template Thurlow which can cover all requirements as needed due to the fact editing a template is available.” However, even assuming for the sake of argument that the rule template allows edits, there is a presumption that a rule template already exists to permit the edits. As stated above, Thurlow discloses that the pre-existing rule templates are used to create the rule rather than using the rule itself to create the rule template. Moreover, Thurlow discloses that it is the rules themselves that are editable (Thurlow: 9:24-27; 10:50-53; Fig. 5). Thus, even if the rules or rule templates of Thurlow allow edits, this does not disclose each and every recited feature of the claims for the reasons above.

Page 26, paragraph 2 of the Office Action further states that “the Examiner will use the concept of ‘classes’ in a object oriented programming language such as C++ or Java to be equivalent to ‘templates.’” However, if the Examiner is combining knowledge in the art with Thurlow, then a rejection under 35 U.S.C. 102(b) is improper because Thurlow itself fails to disclose each and every feature of the claims. Even if Thurlow was combined with the known art of programming languages, then the proposed combination would destroy the functioning of the reference, or make it unsatisfactory for its intended purpose (MPEP 2143.01). For example, the “Rules Wizard” of Thurlow is used so that a rule can be created in a user-friendly manner, so

Applicant : Janaki P. Kumar
Serial No. : 10/824,106
Filed : April 14, 2004
Page : 5 of 5

Attorney's Docket No.: 13906-171001 / 2004P00206US

that a user does not have to use or know about the complexities of employing a programming language to create the rule (Thurlow: 1:49-54; 9:24-36).

Thurlow does not disclose or properly suggest all of the features of the claims. Applicant asks that the rejection under 35 U.S.C. 102(b) be withdrawn, and that claims 1-9, 13-16, 18, and 20 be allowed.

Response to Arguments in Office Action: Item #10, pages 26-27

Paragraph 3, page 27 of the Office Action states that "being able to edit or create a rule illustrates the existence of a rule template." However, such a statement does not provide sufficient reasons for how Thurlow would anticipate each and every claim feature for creating a rule template from a pre-existing rule. The burden to establish anticipation has not been met. Claims 1-9, 13-16, 18, and 20 are allowable for at least all of the reasons discussed above.

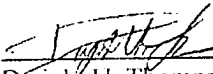
Conclusion

Because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. A formal Notice of Allowance is thus respectfully requested.

Please apply any charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: February 13, 2008


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